REMARKS

Initially, Applicants wish to thank the Examiner for the very helpful telephonic interview conducted on June 12, 2003.

In light of the discussion during the interview, claims 1 and 59 have been amended to recite that the wax of the claimed compositions is present in an amount "of at least 10% by weight relative to the total weight of the composition." Support for this amendment can be found in Applicants' originally-filed specification at least at p. 2, lines 13-14; p. 3, lines 9-10; and p. 5, lines 13-16. As such, no new matter has been added.

Claim 10 has been amended to correct an obvious, typographical error. In particular, it has been amended to recite that "at least one second wax . . ." instead of "at least on second wax . . . ." Because this amendment corrects an error that is obvious, that would be recognized as an obvious error by one skilled in the art, and the correction would be recognized as appropriate, no new matter has been introduced. See M.P.E.P. § 2163.07(II).

Claim 59 has also been amended to recite that the composition comprises "at least two waxes." Support for this amendment is found in Applicants' originally-filed specification at least at p. 5, line 13 - p. 7, line 8. As such, no new matter has been added.

I. Disposition of the Claims

Claims 1-32 and 59 are pending in the present application and all claims stand rejected under the doctrine of obviousness-type double patenting, 35 U.S.C. § 112, first and second paragraphs, and 35 U.S.C. § 102(b). Each ground of rejection will be addressed below.

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

II. Obviousness-type Double Patenting

Claims 1-32 and 59 stand rejected under the judicial doctrine of obviousness-type double patenting over claims 1-27 of U.S. Pat. No. 6,274,131 B1. Without acquiescing to the rejection, but in order to advance prosecution, Applicants file herewith a terminal disclaimer over the parent patent of the present application, U.S. Pat. No. 6,274,131 B1.

III. Rejection Under 35 U.S.C. § 112, First Paragraph

Claims 1-32 and 59 stand rejected under 35 U.S.C. § 112, first paragraph. In particular, the Examiner contends that the limitation that the at least one wax be present in an amount of "at least 9% by weight" relative to the total weight of the composition does not enjoy sufficient written description support in Applicants' originally-filed specification. Applicants respectfully traverse the rejection and maintain that the original specification does provide sufficient support for the limitation of greater than 9% by weight to meet the written description requirement of 35 U.S.C. § 112, first paragraph. Applicants maintain their arguments of record with respect to this rejection. See, e.g., the Response filed December 6, 2002, p. 4, line 18 - p. 6, line 7.

In order to advance prosecution, however, Applicants have amended independent claims 1 and 59 to recite that the wax is present in an amount of "at least 10%" by weight. As such, the present rejection under 35 U.S.C. § 112, first paragraph, is now moot and Applicants respectfully ask that it be withdrawn.

For the record, Applicants maintain that a composition comprising at least one wax present in an amount of at least 9% by weight is sufficiently supported by the original specification and is patentable over the cited references. Applicants are not

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

amending the instant claims for reasons related to patentability and reserve the right to prosecute claims to compositions comprising waxes in an amount of at least 9% by weight in related applications.

IV. Rejection Under 35 U.S.C. § 112, Second Paragraph

Claim 59 stands rejected under 35 U.S.C. § 112, second paragraph, as indefinite. In particular, the Examiner stated that the phrase "at least one wax comprises both a rice bran wax and a polyethylene wax" is unclear. Office Action, dated December 31, 2002, p. 4, lines 1-3. In light of the discussion during the interview, claim 59 has been amended herein to recite that mascara composition comprises "at least two waxes" and that the at least two waxes comprise a rice bran wax and a polyethylene wax. Applicants respectfully contend that this amendment renders the present rejection moot and ask that it be withdrawn.

V. Rejection Under 35 U.S.C. § 102(b)

Claims 1-4, 7-9, 18-22, 24-29, and 32 stand rejected under 35 U.S.C. § 102(b) as anticipated by Arraudeau (U.S. Pat. No. 5,154,916). In particular, the Examiner contends that the reference discloses a mascara composition that meets every limitation of the claim except for the particle size. According to the Examiner, the present claims are anticipated because the same wax(es) are used in Arraudeau as in the present invention. Office Action, dated December 31, 2002, p. 4, lines 11-19. Apparently the Examiner believes that the same wax must have the same particle size.

Applicants respectfully traverse the rejection. Arraudeau does not disclose all the limitations of the instant claims, either explicitly or inherently. Applicants rely on the

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

arguments already of record (see, for example, Response filed December 6, 2002, p. 6, line 16 - p. 7, line 18) and on the additional reasons below.

Generally, in order for a reference to be anticipatory under 35 U.S.C. § 102(b), it must disclose every limitation of the claims at issue, either inherently or explicitly. In this case, the Examiner has failed to show how the particle size limitation recited in the instant claims, requiring the wax particles to be equal to or greater than 1 μm in size, is found in the Arraudeau reference.

The Examiner's position, as explained in the telephonic interview also, is that because the same waxes are used in the Arraudeau reference and because there is no "particular mention that the prior art is a nano or microemulsion," that a wax particle size of greater than or equal to 1 μm is inherent. Applicants respectfully disagree with the Examiner's reading of the reference.

In general, the particle size of a wax contained in a composition such as a mascara is determined by the manner in which the composition is prepared and not by the particular wax that is used. For instance, Example 1 in Applicants' specification, found at p. 18, line 12 - p. 19, line 16, describes a mascara composition comprising several waxes, including carnauba wax. The Example states that the ingredients were mixed together and that a wax-in-water dispersion was obtained in which the wax particles were greater than 1.5 μm in size. In contrast, Example 5, found on p. 22, line 15 - p. 23, line 17, describes the preparation of a mascara composition comprising, among other things, carnauba wax, in which the wax particles were of an average size of 283 nm (0.283 μm). In other words, the compositions of Examples 1 and 5 contain the same wax, yet the wax particle size of each is different due to the manner in which

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com

they were prepared. The instant claims would read on the composition of Example 1, in which the wax particle size was 1.5 μm. But, the instant claims would not read on the mascara composition described in Example 5 in which the wax particle size was 283 nm (0.283 μm), less than the "at least 1 μm in size" limitation required by the instant claims. Accordingly, the Examiner's assertion that the wax particle size must be the same in the instant compositions and those of Arraudeau because they contain the same types of waxes is incorrect. Rather, as these examples illustrate, the wax particle size is a property that is not necessarily determined by the type of wax that is used. Because a particle size of at least 1 μm is not necessarily inherent in the compositions of Arraudeau, the instant claims are not inherently anticipated. As such, Applicants respectfully ask that it be withdrawn.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: July 25, 2003

By: 
Jeffrey H. Tidwell
Reg. No. 47,995

554340_1.DOC

FINNEGAN
HENDERSON
FARABOW
GARRETT &
DUNNER LLP

1300 I Street, NW
Washington, DC 20005
202.408.4000
Fax 202.408.4400
www.finnegan.com